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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,619	03/12/2001	Glen McLean Harris	HARR-003	3161

7590 11/16/2004  
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EXAMINER

AKLILU, KIRUBEL

ART UNIT PAPER NUMBER

2614

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/804,619	HARRIS ET AL.	
	Examiner	Art Unit	
	Kirubel Aklilu	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/04;4/04;12/04</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The disclosure is objected to because of the following informalities: Line 28 of page 11 is referring to electronic system as unit 110 which is inconsistent with previous and subsequent reference to electronic system as unit 100. Appropriate correction is required.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 16 (a) discloses "initializing" of event data however "initializing" is not properly defined in the specification.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29

Art Unit: 2614

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-<sup>9</sup>~~20~~ of copending Application No. 09/804620. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The Applicant is notified that a provisional statutory double-patenting rejection will be made on the copending application number 09/804620.

2. The subject matter of claims 1-9 can be found in corresponding claims 1-9 of application 09/804620.
3. **Claim 1** of application 09/804620 differs from claim 1 of the present application in that claim 1 of application 09/804620 further requires the media content access system to be "passive" by NOT requiring the

input means to further indicate when said electronic system should log event data comprised of said current time, said current date and said current channel. However, Darbee (US patent application # 6,130,726) disclose a remote control that passively monitors a user's viewing habits and stores event data into the remote control's memory (see col. 10 lines 14-20 "it is possible for the software application running on the remote control unit 10 to obtain and cause to be stored in memory data indicative of the viewing habits of one or more users"). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify active media content access system to passively monitor the viewing habits of a user and store in memory event data comprised of said current time, said current date and said current channel. One of ordinary skill in the art would have been motivated to do this to make the active media content access system more automated and require less effort from the user in indicating what event data to store into the remote control.

4. **Claim 2** of application 09804620 differs from Claim 2 of 09804619 in that application 09804619 requires the input means to include a selection button as opposed to 09804620 requires a keypad. However, it is well known in the art that a keypad is normally present for an input means as described in the active media content access system of claim 1.

Art Unit: 2614

5. The limitations of **Claims 3-9** of application 09804620 fall within the limitations of Claims 3-9 of application 09804619, and are rejected accordingly.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee (US patent # 6,130,726) in view of Saib et al. (US Patent # 6,505,346 B2).

1. In regards to **Claim 1**, Darbee teaches a passive media content access system, comprising:  
  
a **control station** (See col. 10 line 29 “. . . to be transmitted to an associated set-top converter box and on to a given **content provider or host system**”);  
  
a **housing** (see Fig. 1, col. 6 lines 53-58, Abstract “The remote control device may comprise a housing . . .”);

an electronic system (see col. 2 lines 51-55 “. . .a remote control unit that is provided with a bidirectional communication capability and with intelligence for monitoring program selection data entered into the unit by a user”) capable of storing (see col. 10 lines 14-18 “. . . it is possible for the software application running on the remote control unit **10** to obtain and cause to be **stored** in memory data . . .”) and uploading (see col. 10 lines 24-29 “It is also possible for the software application running on the remote control selection history data . . .to be **transmitted** to an associated set-top converter box and on to a given content provider or host system) event data relating to at least one media event, wherein said electronic system contains a current time, current date, current device (see col. 10 lines 20-23 “In embodiments where the remote control unit **10** is used in conjunction with a personal computer or web computer, the data stored may also include an internet address or URL designation stamp”) and current channel; (see col. 10 lines 18-20 “The data stored may include for example, a date stamp, time stamp and/or channel identification data.); a communication device connected to said electronic system for uploading said event data to said control station (see col. 10 lines 29-32 “Alternatively, such an information transfer

might be effected using an IR or RF link to a personal computer using a more conventional modem port.”); an input means connected to said electronic system (see Fig. 1 unit 15; col. 6 lines 52-61 “. . . the remote control device 10 may include . . . a keyboard 15 including volume up and Down key . . .”).

Darbee does not expressly teach the input means connected to said electronic system to indicate when said electronic system should log event data comprised of said current time, said current date and said current channel. However, Saib et al disclose a remote control with a special button called “PRGM” for storing favorite channels into memory (see Saib et al col.1 lines 34-41 “the remote for the cable box has a favorite channel operation using a separate key labeled “PRGM” for adding favorite channels to a favorite channel queue in a semi-permanent way.”). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the remote control of Darbee to include a specific button on the remote control, such as the “PRGM” button of Saib, for indicating when said electronic system should log event data comprised of said current time, said current date and said current channel. One of ordinary skill in the art would have been motivated to



do this to make to give the user of the remote control more control over what event data is stored in the remote control. By having a special button designed to indicate when said electronic system should log event data, the user has the added option of storing event data related to a program the user is interested in but the program is broadcast on a channel the user typically does not watch.

2. As for **Claim 2**, Darbee teaches the active media content access of Claim 1, wherein said input means includes a selection button (see fig. 1 unit 16, 18, 22, 25 col. 6 line 52-67 “ . . . a keyboard 15 including a volume Up and Down key, channel Up and Down key . . .”).
3. As for **Claim 3**, Darbee teaches the active media content access of Claim 1, wherein said input means includes a display (see Fig. 1 unit 14; col. 6 lines 52-54 “ . . . the remote control device 10 may include on a top panel 12 therefor a LCD visual display 14 . . .”) and a key pad (see col. 4 line 14-15 “a keypad provided on the face of the remote control.”).
4. As for **Claim 4**, Darbee teaches the active content access system of Claim 3, wherein said electronic system is capable of receiving user preference data relating to personal preference (see col. 3 lines 58-64 “ . . . it may be an object for the remote control to store only a subset of available

program guide and/or advertising information. The subset can be limited for example, to specific channels, specific areas of interest, specific genres of programming, or specific times.”).

5. As for **Claim 5**, Darbee teaches the active media content access system of Claim 4, wherein said control station is in communication with a plurality of programming stations (see col. 9 lines 21-22 “The database for the guide which is broadcast to a given region preferably will cover all of the television stations . . .”) for receiving updated media event information (see col. 9 lines 16-18 “ In one such embodiment, new program guide data might be provided to the remote control unit **10** . . .”).
6. As for **Claim 6**, Darbee teaches the active media content access system of Claim 5, wherein said control station compares said event data to said media event information to determine what type of information to send to said user (see col. 10 lines 32-43 “once data indicative of the particular viewing habits, content selection characteristics or interests of a particular remote control user or group of users is transmitted to the content provider or host system, the content provider or host system may tailor additional programming, advertising, or other content to be provided to

the remote control unit 10.”). The examiner is interpreting the “said event data” to be “content selection characteristics or interests of a particular remote control use, and “media event information” to be the additional programming, advertising, or other content to be provided to the remote control unit 10. And in the process of tailoring the additional programming, advertising, and other content to the user, the content provider has to compare the selection’s characteristics.

7. As for **Claim 7**, Darbee teaches the active media content of Claim 6, wherein said control station is programmable by said user to reflect said personal preference (see col. 3 lines 31-49 “ . . . advertising and programming data may be selectively downloaded to and stored within the remote control based on preferences of the user.”).
8. As for **Claim 8**, Darbee teaches the active media content access system of Claim 7, wherein said personal preference includes type of information to receive relating to said media event (see col. 3 lines 58-64 “ . . . it may be an object for the remote control to store only a subset of available program guide and/or advertising information. The subset can be limited to specific channels, specific areas of user interests, specific genres of programming, or specific times”). The

examiner is interpreting "types of information" to mean types of channels, types of areas of user interest, types of genres of programming, and types of information that may be broadcast at different times. Therefor, the personal preference the user specifies includes type of information to receive relating to said media event.

9. As for **Claim 9**, Darbee teaches the active media content access system of Claim 8, wherein said communication device is in communication with said control station via a global computer network (see col. 4 lines 19-32 "in some embodiment of the present invention, traditional broadcast sources such as cable, satellite and network broadcast channels may be bypassed and alternative data links to the remote control may be provided . . . including wireless and non-wireless links to the Internet.")).
10. As for **Claim 10**, Darbee teaches a method of using an active media content access system having an electronic system with a communication device and an input device, wherein said communication device is in communication with a control station, said method comprising the steps of:
  - (a) viewing a television event;
  - (b) receiving a log event data indication from a user

(c) logging an event data within said electronic system, wherein said event data is comprised of a current date, a current time, a current device;

All the limitations above fall within the limitation of Claim 1 and are rejected accordingly.

11. As for **Claim 11**, Darbee teaches the method of using an active media content access system of Claim 10, including the step of:

(d) uploading said event data to said control station (see col. 10 lines 24-29 "It is also possible for the software application running on the remote control selection history data . . . to be **transmitted** to an associated set-top converter box and on to a given content provider or host system).

12. As for **Claim 12**, the method of using an active media content access system of Claim 11, including the steps of:

(e) determining an identity of said media event from said event data;.

the above limitation (d) is analyzed with respect to claim 10.

Alexander teaches a method of using a user profile to create a "watch list" wherein the Electronic Program Guide uses event data (the viewer viewing habits such as channels watched and times when said channels are watched. See col. 28 lines 30-52) to create a user profile, which in turn

may be used to create the "watch list" (see Alexander col. 31 lines 25-33). The examiner is interpreting the steps of creating a watch list of channels based on information collected from the viewer's viewing habits as determining an identity of said media event from said event data.

(f) determining whether information is available regarding said media event (see Darbee col. 10 lines 38-43. "the serial number, address and/or user information maintained within the memory of the remote control unit 10 may be used to filter and/or parse data, including programming information, advertising or other content . . .").

13. As for **Claim 13**, Darbee teaches the method of using an active media content access system of Claim 12, including the step of:

(g) providing available information to said user (see col. 10 lines 32-38 "once data indicative of the particular viewing habits, content selection characteristics or interests of a particular remote control user is transmitted to the host, the host system may tailor additional programming, advertising, or other content to be provided to the remote control unit 10).

14. As for **Claim 14**, the claim differs from Darbee in that it further requires the method of using a passive media content access system of Claim 13, including the step of:

(h) sending an e-mail containing said available information to said user. Darbee does however teach that "... traditional broadcast sources such as cable, satellite and network broadcast channels may be bypassed and alternative data links to the remote control may be provided ... such as wireless and non-wireless links to the internet" (see col. 4 lines 26-32). It is well known in the art that e-mail is a prominent means of sending information when Internet communication is available. Email is an attractive means of communication because the recipient has the option of accessing the email message at his/her convenient time. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Darbee's means of providing available information to the user to be of an e-mail format. One would have been motivated to do this if Internet access was available between the remote control unit and the host system and the user can access the email message at a time that is convenient to him/her.

15. As for **Claim 15**, Darbee teaches the method of using a passive media content access system of Claim 12, including the step of:

(g) providing available information depending upon predefined user preference (see col. 10 lines 32-38 "once data indicative of the particular viewing habits, content selection characteristics . . . is transmitted to the content provider or host system . . . host system may tailor additional programming, advertising or other content to be provided to the remote control unit 10.").

16. As for **Claim 16**, a method of using a passive media content access system having an electronic system with a communication device and an input device, wherein said communication device is in communication with a control station, said method comprising the steps of:

(a) initializing a current date, a current time, a current device and a current channel into said electronic system; These limitations fall within the limitation of claim 10 (c) and are rejected accordingly.

(b) viewing a television event; This limitation falls within the limitation of Claim 1 and is rejected accordingly.

(c) receiving a log event data indication from a user; This limitation falls within the limitation of Claim 1 and is rejected accordingly.

(d) logging an event data within said electronic system, wherein said event data is comprised of a current date, a



current time, a current device and a current channel at the time of logging said event data. This limitation falls within the limitation of claim 10 (c) and is rejected accordingly.

17. As for **Claim 17**, Darbee teaches the method of using an active media content access system of Claim 18, including the step of:

(e) uploading said event data to said control station. This limitation falls within the limitation of claim 11 and is rejected accordingly.

18. As for **Claim 18**, Darbee teaches the method of using a passive media content access system of Claim 19, including the steps of:

(f) determining an identity of said media event from said event data;. This limitation falls within the limitation of claim 12 (e) and

(g) determining whether information is available regarding said media event. This limitation falls within the limitation of claim 12 (f) and is rejected accordingly.

19. As for **Claim 19**, the method of using an active media content access system of Claim 18, including the step of:

(h) providing available information to said user

The above limitation falls within the limitation of claim 13 (g) and is rejected accordingly.

20. As for **Claim 20**, the method of using an active media content access system of Claim 19, including the step of:  
(i) sending an e-mail contacting said available information to said user.

The above limitation falls within the limitation of claim 14 (h) and is rejected accordingly.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirubel Aklilu whose telephone number is 703-305-8144. The examiner can normally be reached on 9:00AM - 5:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2614

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KA

November 10, 2004



NGOC-YEN VU  
PRIMARY EXAMINER